

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER J. BERIONT and
MEHMET MUSTAFA

MAILED

Appeal No. 96-2381
Application 08/220,953¹

DEC 21 1998

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER REMANDING TO THE EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)² was amended to provide as follows:

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner (underlining added for emphasis):

¹ Application for patent filed March 31, 1994. According to appellants, the application is a continuation of Application 07/815,456, filed December 31, 1991; which is a continuation-in-part of Application 07/790,039, filed November 12, 1991.

² 60 Fed. Reg. 14518 (Mar. 17, 1995), 1173 Off. Gaz. Pat. & Trademark Office 62 (Apr. 11, 1995).

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A Statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representatives, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The brief filed October 20, 1995 (Paper No. 23), is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to both the "real party in interest" and "related appeals and interferences."

The ***Manual of Pat. Examining Procedure*** (MPEP) § 1206 (7th ed., July 1998) states:

If appellant does not name the real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

... While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest.

The MPEP § 1206 further states:

... If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

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The examiner may presume that the real party in interest is the party named in the caption of the brief and that there are no related appeals and interferences, *if* appellants present the headings but fails to provide the corresponding statements under the headings. Nevertheless, the examiner is encouraged to request from appellants not only the required headings but also explicit statements naming the real party in interest and identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require appellants to explicitly identify the real party in interest and any related appeals and interferences.

Additionally, the CONTENTS portion of the file wrapper indicates that on December 5, 1996 a "Notice of Acceptance" (Paper No. 26) was mailed. However, we are unable to locate a copy of this paper in the application file. A physical review of the record reveals a handwritten note, which states "O.K. To ENTER B.W. 12/5/96" in the left-hand column of the "Revocation/Power of Attorney" entered September 16, 1996 (Paper No. 25), and, accordingly, the Notice of Acceptance was *not* entered in the official record.

Accordingly, it is

ORDERED that the application is remanded to the examiner for resolution of the issues set forth above regarding both the "real party in interest" and "related appeals and interferences," and it is

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FURTHER ORDERED that the application is remanded to the examiner for notification to appellants *in writing* of the entry or non-entry of the Notice of Acceptance (Paper No. 26), and for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES



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